

Application No.: 09/785,760
Response to OA of 11/07/05

Remarks

In the present response, three claims (4, 15, and 16) are amended. No new matter is entered. Claims 4 – 26 are presented for examination.

I. Claim Rejections: 35 USC § 103

Claims 4 – 26 are rejected under 35 USC § 103 as being unpatentable over USPN 2002/0111892 (Sharp) in view of USPN 6,202,051 (Woolston). This rejection is traversed.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Applicant asserts that the rejection does not satisfy these criteria.

No Suggestion/Motivation to Modify/Combine References

For at least the following reasons, no suggestion or motivation exists to modify or combine Sharp and Woolston.

First, Applicant argues that no teaching or suggestion exists to make the combination because the references are directed to completely different inventions. Sharp is directed to a marketplace for the sale and purchase of freight transportation services ([0005], [0060]). In other words, Sharp is concerned with buying and selling freight shipping services. By contrast, Woolston teaches a network of consignment nodes for the sale and purchase of used and collectible goods (1: 13-18; 2: 27-44). Woolston does not mention or even suggest auctioning or selling services. Again, Woolston is primarily concerned with selling collectables (i.e., goods).

The Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention

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absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Such teaching or suggestion does not exist.

Second, Applicant argues that no teaching or suggestion exists to make the combination because the references are directed to solving completely different problems. In Sharp, the Background section expressly discusses the problems with prior internet freight shipping services. Sharp solves these problems with a marketplace for selling freight shipping services. By contrast, Woolston solves a completely different problem. In Woolston, the Background section discusses the problems that prior electronic consignment stores did not provide an adequate "means to electronically market used goods or provide an avenue to allow participants to speculate on the price of collectable or used goods in an electronic market place" (1: 29-33). Thus, the inventions in Sharp and Woolston solve completely different problems.

To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). In light of the completely different inventions and problems being solved in Sharp and Woolston, no suggestion or motivation exists to combine or modify these references.

For at least these reasons, Applicant respectfully asks the Examiner to withdraw the rejection since a *prima facie* case of obvious has not been established.

Response to Examiner's Arguments on Combination

In order to justify the combination and modification of Sharp and Woolston, the Examiner argues:

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Sharp to provide shipping for goods sold at the auction of Woolston because this would provide

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a cost effective transport services at a lowest cost to buyer and seller.

Applicant respectfully disagrees since the references themselves do not teach the proposed modification. In fact, Woolston expressly discusses the shipment of goods from the seller to the buyer:

If the participant has elected to ship goods then the consignment node will print a shipping label 404 for the consignment node user to attach to the good for shipment. The transfer ownership routing may then exit 416. (Col. 12, line 65 – col. 13, line 1).

Thus, Woolston already provides a solution for shipping the goods: The consignment node user (i.e., the seller) prints a shipping label and ships the goods to the buyer. Nowhere does Woolston itself teach or even suggest using an auction to secure a shipper for sending the goods. Thus, Applicant respectfully argues that the teachings of the references themselves are contrary to the arguments of the Examiner.

The Examiner is performing an improper piecemeal construction that uses hindsight to arrive at the claim elements. In other words, the Examiner is picking and choosing teachings from Sharp and Woolston with hindsight of Applicant's invention to allegedly modify the express teachings of Sharp and Woolston to obviate the pending claims. Such hindsight reconstruction is not proper. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

All Elements Not Taught or Suggested

All of the elements of the claims are not taught or suggested in Sharp and Woolston. In other words, evening assuming *arguendo* that Sharp and Woolston are successfully combinable (which they are not), the alleged combination does not teach or suggest all the elements in the claims. Examples for the independent claims are provided below.

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Independent Claims 4 and 16

Independent claims 4 and 16 and their dependent claims recite numerous limitations that are not taught or suggested in Sharp and Woolston. Claim 4 is selected for discussion.

Claim 4 is amended to recite an auction on a portal for the sale of a good. Claim 4 then recites "sending, by the portal, the buyer a shipping form to gather a set of shipping data about shipping the good after the buyer and the seller agree for the sale of the good." Nowhere do Sharp and/or Woolston teach or suggest these recitations. As noted above, Sharp is concerned with buying and selling shipping freight services. Further, Sharp never mentions or suggests that the portal sends the buyer a shipping form after the buyer and seller agree for the sale of a good. Further, Woolston expressly teaches that once the buyer and seller agree to ship the goods, "then the consignment node will print a shipping label 404 for the consignment node user to attach to the good for shipment. The transfer ownership routing may then exit 416" (see col. 12, line 65 – col. 13, line 1).

For at least these reasons, independent claims 4 and 16 are allowable over Sharp and Woolston. The dependent claims are allowable for at least these reasons.

Independent Claim 15

Independent claim 15 recites selecting a winning buyer for shipping goods in an unused capacity of shipping services. The claim then recites "sending, automatically by the portal if a seller agrees to ship the goods in the unused capacity, the winning buyer a shipping form to gather information about the goods being shipped in the unused capacity." Nowhere do Sharp and/or Woolston teach or suggest these recitations. As noted above, Sharp is concerned with buying and selling shipping freight services. Further, Sharp never mentions or suggests that the portal automatically sends the buyer a shipping form to gather information about shipping goods in unused capacity. Further, Woolston expressly teaches that once the buyer and seller agree to ship the goods, "then the consignment node will print a shipping label 404 for the consignment node user to attach to the good for shipment. The transfer ownership routing may then exit 416" (see col. 12, line 65 – col. 13, line 1).

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For at least these reasons, independent claim 15 is allowable over Sharp and Woolston.

Dependent Claims 8 and 14: Official Notice

The Examiner takes official notice against dependent claims 8 and 14. Under Rule 37 C.F.R. §1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertion. Alternatively, under M.P.E.P. §2144.03, the Examiner is hereby requested to cite a reference in support of the assertion. The Examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained, *see* M.P.E.P. § 2144.04(c); 37 C.F.R. 1.04(c)(2); *see also In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). The Applicant respectfully requests that the Examiner produce documentary evidence in support of his assertion of official notice. Otherwise the rejection of claims should be withdrawn.

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CONCLUSION

In view of the above, Applicant believes that all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Respectfully submitted,


Philip S. Lyren
Reg. No. 40,709
Ph: 281-514-8236

CERTIFICATE UNDER 37 C.F.R. 1.8

The undersigned hereby certifies that this paper or papers, as described herein, is being transmitted to the United States Patent and Trademark Office facsimile number 571-273-8309 on this 27th day of January, 2006.

By 
Name: Carrie McKerley

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